

REMARKS

Claims 1-22 are pending in the instant application and are subject to restriction and an election requirement. The Examiner has not provided groups from within a generic for election, however has required that a species be elected from dependent claim 12 and has recommended that the definition of substituent A be amended in accordance with the species election. Applicants wish to make a provisional election of 4-Methyl-6-{2-[4-(2-methylquinolin-5-yl)piperazin-1-yl]ethyl}-4H-benzo[1.4]oxazin-3-one (the compound of Example 11 - page 61 of the specification) with traverse. Applicants have amended the definition of substituent A to recite heteroaromatic groups.

Applicants traverse the present election/restriction requirement because (i) the present application was filed under the provisions of 35 U.S.C. § 371 and the present election/restriction requirement is not in accordance with the unity of invention standard set forth by the PCT; (ii) it reflects a misapplication of the guidelines of the MPEP and the PCT; and (iii) it fails to identify groups to which prosecution could be restricted.

PCT Rule 13.1 includes within the definition of unity of invention "a group of inventions so linked as to form a general inventive concept". Accordingly, patentably distinct inventions do not lack unity of invention as long as they derive from the same inventive concept. What is required for a holding of lack of unity is that the inventions be truly "independent". This is the standard for lack of unity applied by the court in *In re Harnish*, 206 USPQ 300, 306 (CCPA 1980) ("unity of invention" ... appl[ies] where *unrelated* inventions are involved") (emphasis added). Independent, as defined in MPEP § 802.01, "means that there is no disclosed relationships between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect".

In the instant case, all of the compounds of the remaining claims share: (i) a common design, as represented by the generic core structure (Ia), (ii) a common operation as found by their mechanism of action (5-HT₁ receptor antagonists), and (iii) a common effect (treatment of CNS disorders).

Moreover, the Examiner's restriction requirement is not in accordance with the guidance provided in MPEP § 1850 (section II):

- a) ... it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority

In this case, the International Searching Authority noted only that methods of treatment would not be searched. No unity objections were raised with regard to any of the compound or composition claims.

- b) If ... there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise.

With respect to the present invention, the International Preliminary Examination Report indicated that novelty and inventive step had been satisfied in each of the 22 claims.

- c) Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims

In the present case, the species election is improperly required to be made from dependent claim 12.

- d) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims.

As noted above, the original 22 claims, including independent claim 1, were found to satisfy the requirements for novelty and inventive step.

Applicants contend that for each of the reasons provided above, the present restriction requirement is improper and should be withdrawn.

This response includes a supplemental preliminary amendment which restricts the claimed subject matter to that defined in claim 3. The pending claims are 3-13, 15, 16, 21, and 22, with claim 3 being the sole independent claim. Claims 1, 2, 14, and 17-20 have been canceled without prejudice or disclaimer. The proviso from claim 3 has been removed as it was

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not relevant to the definition of substituent A. Other claims were amended (claim 10) or canceled (claims 14 and 17-20) in order to conform to U.S. practice. Species claim 12 has been amended to coincide with the scope of claim 3, from which it now depends.

In addition, Applicants retain the right to file divisional applications directed to the non-elected subject matter should the restriction requirement become final. Authorization is hereby granted to charge any fees which may be required by this paper, or credit any overpayment, to Deposit Account No. 19-2570.

Respectfully submitted,



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